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The application being filed herewith is a continuation of co-pending U.S. Patent Application Serial No. 10/137,394, filed May 3, 2002 ("the Parent application").

Amendments to the specification

The specification filed herewith is to be amended a set forth above.

Specifically:

1) The title is to be replaced with the new title entered in the Parent application;

2) A "Cross Reference to Related Applications" section has been added at page 1 to assert the continuation status of the application, as set forth above; and

3) The paragraph at page 1, lines 3-6 (regarding assignee's docket item no. 10017582-1) has been updated to include the U.S. Patent Application Serial Number and filing date.

No new matter has been added to the specification.

The drawings

The drawings filed herewith are the substitute drawings filed (and accepted) in the Parent application.

Amendments to the claims

Claims 1, 4, 5, 6, 8, and 15 have been amended as indicated above.
Specifically:

- Claim 1 has been amended to include the limitations of, “an image producing device configured to receive the rasterized print job from the storage device, and wherein the image producing device is external of the processor and the

1 storage device". Support for the amendment is found in Figs. 1 and 2, and in
2 the specification at page 4 line 3.

- 3 • Claims 4 and 5 have been amended to address a lack of antecedent basis for
4 "network".
- 5 • Claim 6 has been amended to depend from claim 4 (whereas it previously
6 depended from claim 1), and to further correct an inconsistency between the
7 "one or more print job generators" of claim 4 and the "print job generator"
8 which was originally recited in claim 6.
- 9 • Claim 8 has been amended to include the limitations of now-cancelled
10 claim 9.
- 11 • Claim 15 has been amended to include the limitations of now-cancelled
12 claims 16 and 17. Claim 15 has been further amended by adding that the
13 external storage device is a networked external storage device. Support for
14 the latter amendment is found in the specification at page 9 lines 15-16.

15
16 Previous Rejection of Claims under 35 U.S.C. § 102

17 In the Parent application, in an Office action dated May 8, 2003, claims 1-17,
18 19, and 22-23 were rejected under 35 U.S.C. § 102 as being anticipated by U.S.
19 Patent No. 5,903,733 ("Hong").

20 The Applicant respectfully disagrees that claims 1-17, 19, and 22-23 are
21 anticipated by Hong.

22 As a starting point, the PTO and the Federal Circuit provide that §102
23 anticipation requires each and every element of the claimed invention to be
24 disclosed in a single prior art reference. (*In re Spada*, 911 F.2d 705, 15 USPQ2d
25 1655 (Fed. Cir. 1990)). The corollary of this rule is that the absence from a cited
§102 reference of any claimed element negates the anticipation. (*Kloster
Speedsteel AB, et al v. Crucible, Inc., et al*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir.

1 1986)). Furthermore, “[a]nticipation requires that all of the elements and limitations
2 of the claims are found within a single prior art reference.” (*Scripps Clinic and*
3 *Research Found. v Genetech. Inc.*, 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010
4 (Fed. Cir. 1991 (emphasis added))). Moreover, the PTO and the Federal Circuit
5 provide that §102 anticipation requires that there must be no difference between the
6 claimed invention and the reference disclosure. (*Scripps Clinic and Research Found.*
7 *v. Genetech, Inc.*, *id.* (emphasis added)). Accordingly, if the Applicant can
8 demonstrate that any one element or limitation in claims 1-17, 19, and 22-23 is not
9 disclosed by Hong, then the respective claim(s) must be allowed.

10 In the following arguments, the Applicant will focus in particular on
11 independent claims 1, 8, 12, 15 and 23, as the Applicant believes those claims to be
12 allowable (as either originally presented, or as amended above) over Hong. It is
13 axiomatic that any claim which depends from an allowable base claim is also
14 allowable, and therefore the Applicant does not believe it is necessary to present
15 arguments in favor of each and every dependent claim.

17 Claim 1

18 The Applicant contends that claim 1 (as amended), and claims 3-7 which
19 depend therefrom, are not anticipated by Hong. With respect to independent claim
20 1, that claim includes the following limitations:

21
22 A printing system comprising:
23 a processor configured to generate a rasterized print job from a
24 print job;
25

1 a storage device coupled to the processor and configured to
2 store the rasterized print job, said storage device located externally of
3 the processor; and

4 an image producing device configured to receive the rasterized
5 print job from the storage device, and wherein the image producing
6 device is external of the processor and the storage device.

7 (Emphasis added.)
8

9 As can be seen, Applicant's claim 1 requires the processor to generate the
10 rasterized print job, and for the image producing device to be external of the
11 processor and the storage device. In the apparatus described by Hong, the
12 rasterizing is done in the "Host" 110b (see Hong col. 6 lines 44-47), presumably by
13 processor 255. Accordingly, it is the processor 255 of Hong which is relevant, and
14 not the processor 260 in the MFP 110a (which is an image producing device). After
15 rasterization by the Host 110b, the print job is transmitted to the MFP 110a (see
16 Hong col. 6 lines 44-47). Hong does not describe storing the rasterized print job in
17 memory. However, even if the rasterized print job could be stored in the Host 110b
18 (by disk memory 280 or RAM memory 250), or in the MFP 110a (by RAM 265), none
19 of these memory devices are external to both the processor and the image
20 producing device, as is required by Applicant's claim 1 ("wherein the image
21 producing device is external of the processor and the storage device").

22 For at least these reasons, the Applicant contends that claim 1 is not
23 anticipated by Hong. Since claims 3-7 depend from claim 1 (either directly or
24 indirectly), these claims include the limitations of claim 1. Accordingly, claims 3-7
25 are also allowable over Hong. The Applicant therefore requests that claims 1 and 3-
7 be allowed.

1 Claim 8

2 The Applicant contends that claim 8, and claims 10-11 which depend
3 therefrom, are not anticipated by Hong. With respect to independent claim 8, that
4 claim includes the following limitations:

5
6 An image producing device comprising:

7 a processor with software configured to receive an instruction
8 and, in response to said instruction, retrieve a print job from a storage
9 device external to said image producing device; and

10 wherein said device is configured to generate a rasterized print
11 job and send the rasterized print job to an external storage device.

12 (Emphasis added.)

13
14 As previously indicated, claim 8 has been amended to include the limitations
15 of now-cancelled claim 9.

16 As described above with respect to claim 1, Hong describes the rasterizing of
17 the print job as being done in Host 110b (presumably by processor 255), which is
18 external of the MFP 110a (which is an image producing device) (see Hong col. 6
19 lines 44-47). That is, the MFP 110a ("image producing device") of Hong is not,
20 "configured to generate a rasterized print job and send the rasterized print job to an
21 external storage device", as is required by Applicant's claim 8. Even if the Host 110b
22 and MFP 110a of Hong could be considered as collectively comprising "an image
23 producing device" (which the Applicant does not concede), it would still not anticipate
24 Applicant's claim 8, as claim 8 requires the storage device to be external of the
25 device, and Hong does not provide for external storage.

1 For at least these reasons, the Applicant contends that claim 8 is not
2 anticipated by Hong. Since claims 10 and 11 depend from claim 8, these claims
3 include the limitations of claim 8. Accordingly, claims 10 and 11 are also allowable
4 over Hong. The Applicant therefore requests that claims 8, 10 and 11 be allowed.

5
6 Claim 12

7 The Applicant contends that claim 12, and claims 13 and 14 which depend
8 there from, are not anticipated by Hong. With respect to claim 12, that claim
9 includes the following limitations:

10
11 A method for use in creating an image on print media said
12 method comprising the steps of:

13 determining that a print job should be **divided** among multiple
14 image producing devices; and

15 sending **said print job** to multiple image producing devices.

16 (Emphasis added.)
17

18 As can be seen, Applicant's claim 12 requires that the print job be divided
19 among multiple image producing devices. Further, Applicant's claim 12 requires that
20 the print job (not multiple print jobs, but one print job) be sent to multiple image
21 producing devices. Hong does not provide for either of these steps. As described at
22 column 7 lines 19-39, Hong provides for the Host 110b (Figs. 2 and 3) to send
23 multiple print jobs to the different functional subsystems (310, 315, 320, 325, 330
24 and 335) of MFP 110a, each print job being sent to a different subsystem. That is,
25 Hong does not provide for a print job to be sent to multiple image producing devices,
as is required by Applicant's claim 12. Further, Hong makes no mention or
suggestion of dividing a print job, as is also required by Applicant's claim 12.

1 For at least these reasons, the Applicant contends that claim 12 is not
2 anticipated by Hong. Since claims 13 and 14 depend from claim 12, these claims
3 include the limitations of claim 12. Accordingly, claims 13 and 14 are also allowable
4 over Hong. The Applicant therefore requests that claims 12-14 be allowed.

5
6 Claim 15

7 The Applicants contend that claim 15, and claims 19-22 which depend there
8 from, are not anticipated by Hong. With respect to claim 15, that claim includes the
9 following limitations:

10
11 A method for use in creating an image on print media said
12 method comprising the steps of:

13 receiving an unrasterized print job from a device on a network;

14 processing said unrasterized print job into a rasterized print job;

15 sending the rasterized print job to a **networked** external storage
16 device;

17 retrieving the rasterized print job from the **networked** external
18 storage device; and

19 generating an image from said rasterized print job using an
20 image producing device.

21 (Emphasis added.)

22
23 As indicated above, claim 15 has been amended to add the limitations of now-
24 cancelled claims 16 and 17, and by adding that the external storage device is a
25 networked external storage device.

1 As can be seen, Applicant's claim 15 includes the intermediate steps
2 (following rasterization, and prior to generating the image) of sending the rasterized
3 print job to a networked external storage device, and then retrieving the rasterized
4 print job from the networked external storage device. As described above with
5 respect to claim 1, Hong does not describe storing the print job after it has been
6 rasterized. Even assuming that the rasterized print job could be stored in one of the
7 memory components 250, 280 or 256 (Fig. 2, Hong), none of those memory devices
8 are external memory devices, nor are they networked memory devices, both as
9 required by applicant's claim 15. While the memory devices 250, 280 and 256 of
10 Hong may reside in devices connected to a network (see Fig. 1 of Hong), that does
11 not make them "networked" memory devices. The file server 120 of Hong (Fig. 1)
12 could be considered a networked external memory device, but Hong simply does not
13 teach or suggest storing or retrieving a rasterized print job from the file server 120 (or
14 any equivalent device).

15 For at least these reasons, the Applicant contends that claim 15 is not
16 anticipated by Hong. Since claims 19-22 depend from claim 15, these claims include
17 the limitations of claim 15. Accordingly, claims 19-22 are also allowable over Hong.
18 The Applicant therefore requests that claims 15 and 19-22 be allowed.

19
20 Claim 23

21 The Applicant contends that claim 23 is not anticipated by Hong. Claim 23
22 includes the following limitations:

23
24 (Continued on next page.)
25

1 A printing system comprising:
2 means for printing including means for rasterizing a print job to
3 produce a rasterized print job;
4 means for transmitting said rasterized print job externally of said
5 means for printing;
6 means for storing said rasterized print job externally of said
7 means for printing; and
8 means for retrieving said rasterized print job back to said means
9 for printing.
10 (Emphasis added.)
11

12 As can be seen, Applicant's claim 23 includes a "means for printing" that
13 **includes** a means for rasterizing a print job. As describe above with respect to
14 claim 1, Hong's "means for printing" (MFP 100a, Fig. 2) does not include a "means
15 for raserizing", as it is very clear (col. 6 lines 44-47) that all rasterizing of print jobs is
16 done in the Host 110b. Even assuming that the Host 110b and MFP 110a of Hong
17 could be together considered together as a "printing system" (which the Applicant
18 does not concede), Applicant's claim 23 includes the limitation of a "means for
19 storing said rasterized print job externally of said means for printing", which is not
20 taught or suggested by Hong.

21 For at least these reasons, the Applicant contends that claim 23 is not
22 anticipated by Hong. The Applicant therefore requests claim 23 be allowed.
23

24 Previous Rejection of Claim 20 under 35 U.S.C. § 103(a)

25 In the Parent application claim 20 was been rejected under 35 U.S.C. § 103
as being obvious over U.S. Patent No. 5,903,733 ("Hong") in view of U.S. Patent No.
5,559,933 ("Boswell").

1 Claim 20 depends from claim 15. For the reasons set for above with respect
2 to claim 15, the Applicant contends that claim 15 (as amended) is allowable.
3 Further, in order for a claim to be obvious, M.P.E.P. §2143.03 provides that "all claim
4 limitations must be taught or suggested" [by the prior art] to sustain a rejection under
5 §103. (Emphasis added). Claim 20, by virtue of its dependency from claim 15,
6 inherently contains the following limitations:

7
8 A method for use in creating an image on print media said
9 method comprising the steps of:

10 receiving an unrasterized print job from a device on a network;

11 processing said unrasterized print job into a rasterized print job;

12 sending the rasterized print job to a **networked** external storage
13 device;

14 retrieving the rasterized print job from the **networked** external
15 storage device; and

16 generating an image from said rasterized print job using an
17 image producing device.

18
19 As described above with respect to claim 15, Hong does not describe storing
20 the print job after it has been rasterized, the use of external memory devices for
21 storing the rasterized print job, or the use of networked memory devices for storing
22 the rasterized print job. Boswell does not cure this deficiency.

23 For at least these reasons the Applicant contends that claim 20 is not obvious
24 over Hong in view of Boswell, and therefore respectfully requests that the rejection of
25 claim 20 be removed and the claim allowed.

1 New claim

2 New claim 24 has been added. Claim 24 includes the following limitations:

3
4 A printing system comprising:

5 a processor configured to generate a rasterized print job from a
6 print job;

7 a storage device coupled to the processor and configured to
8 store the rasterized print job, said storage device located externally of
9 the processor; and

10 an image producing device configured to house the processor.
11

12 Applicant's new claim 24 essentially comprises original claim 1 plus (now
13 cancelled) claim 2. The Applicant notes that new claim 24 differs from Hong as
14 follows: in Applicant's new claim 24, the processor that is configured to generate the
15 rasterized print job is housed within the image producing device, whereas Hong
16 provides that the processor (255, Fig. 2 of Hong) configured to generate the
17 rasterized print job is external of the image producing device (MFP 110a, Fig. 2 of
18 Hong). (See Hong, col. 6 lines 44-47.) The Applicant therefore contends that new
19 claim 24 is novel in view of Hong. Further, the Applicant contends that new claim 24
20 is not obvious over Hong in view the cited references.

21 For at least these reasons the Applicant contends that new claim 24 is
22 allowable, and respectfully requests timely allowance of the same.
23

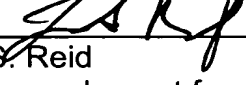
24 (Continued on next page.)
25

1 The Examiner is respectfully requested to contact the below-signed
2 representative if the Examiner believes this will facilitate prosecution toward allowance of
3 the claims.

4
5 Respectfully submitted,

6 Todd Alexander LUTZ

7
8 Date: July 30, 2003

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